

unique features and steps of the present invention as disclosed in the specification as originally filed. In this regard, claims 21 and 22 are fully supported by the specification as originally filed and neither claims adds new matter. Claim 1 now depends from new claim 21 and claim 2 as amended now depends from new independent claim 22. As will be explained hereinafter, claims 21 and 22 patentably distinguish over the prior art of record and thus claims 21 and 22 and each of their respective dependent claims are now in condition for immediate allowance.

New independent claim 23 is broader in scope than new claim 21 but is directed to the same invention. In this regard, new claim 23 and its dependent claims 24-32 are directed to a fashion wear item that is fully disclosed in the specification as originally filed. New claim 33 is a method claim that is broader in scope than claim 22.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested.

#### **Drawing Corrections**

The examiner has objected to the drawings. Responsive to this objection, attorney for applicant has submitted a new set of formal drawings to be substituted for the informal drawings originally submitted. The formal drawings are substantially similar to the informal drawings as originally filed and do not add new matter.

#### **Allowed and Allowable Claims**

Attorney for applicant gratefully acknowledges that the examiner has found that claims 4, 5, 9 and 10 to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 4, 5, 9, and 10 have therefore been rewritten in independent form to include their respective base claim

limitations. Accordingly, claims 4-5 and 9-10 are now in condition for immediate allowance since claims 4-5 and 9-10 have been found to be allowable if rewritten in independent form.

### **Rejections**

#### **Rejections Under 35 USC §103**

Claims 1-3, 7-8, and 12-20 have been rejected under 35 USC §103 as being unpatentable over *Innis* (U.S. 1,980,621).

Claim 1 as amended, and its dependent claims 3 as amended as well as claims 7, 13, 15, 17, and 19 patentably distinguish over the *Innis* reference because claim 1 as amended emphasizes the novel features of the present invention. In this regard, claim 1 as amended now depends from new claim 21 which specifies:

"21. A novelty fashion wear item, comprising:

a flexible pad having an upper surface and a lower surface  
with a non-slip texture;

said pad being sufficiently flexible to conform to a contoured surface area  
of a body part;

said pad having its upper surface coated with an adhesive material for  
removably securing said pad to said contoured surface area a body part  
to facilitate decorating said contoured surface area; and

said pad having its lower surface provided with indicia to decorate  
said contoured surface area."

The *Innis* reference teaches a pleated elongated sheet (10) that is substantially larger than the foot of a user extending both beyond the front of the toes and the rear of the heel. The sheet (10) includes a pair of holes (11) that are disposed at about each end of the sheet. A pair of patches indicated generally as (P) are adhesively secured to the underside

of the heel at about each of the holes (11). In this regard, each patch (P) includes a panel or disc (13) that is substantially larger than the hole (11) and which has its upper surface coated with a layer of waterproof adhesive (12). The adhesive (12) secures the disc (13) to the undersurface of the sheet (10) and includes a small area that is exposed to the air through the hole (11). The *Innis reference* further teaches that the elongated sheet (10) is attached to foot of the user by applying one of the patches (12-13) to the heel of the user and the other one of the patches (12-13) to the ball of the foot as shown in FIG. 1.

The novel features and steps of the present invention are not disclosed, nor suggested by the *Innis reference* in that the *Innis reference* fails to disclose or teach "a flexible pad having an upper surface and a lower surface with a non-slip texture..." Instead, the *Innis reference* teaches a sanitary sandal with a "sole (10) that is impregnated with a chemical which, under the action of water, will release either chlorine, oxygen or a gas of similar nature which may result in the formation of a germicidal solution." The *Innis reference* further teaches that the sole (10) is a cellulose product, glassine or any other cheap sheet material, that is suitable, the idea being that after one use the device is thrown away. In short then, the *Innis reference* is completely silent relative to "a flexible pad having a non-slip texture."

Secondly, the *Innis reference* does not teach, nor suggest, "said pad being sufficiently flexible to conform to a contoured surface area of a body part." Instead, *Innis reference* "a single piece of thin sheet material which may or may not be flexible as desired" As best seen in FIGS. 1-5 of the *Innis reference* the sheet or sole (10) is shown in a flat form only without sufficient flexibility to conform to the instep of the foot of the user (for example see FIG. 1 in particular). Thus, the *Innis reference* fails to teach or suggest "said pad being sufficiently flexible to conform to a contoured surface area of a body part."

Thirdly, the *Innis reference* does not teach, nor suggest "said pad having its upper surface coated with an adhesive material for removably securing said pad to said contoured surface area a body part to facilitate decorating said contoured surface area...." Instead, the *Innis reference* teaches that a disc or panel 13 having an adhesive coating is secured to the underside or bottom of the sole (10) in proximity to a hole (11), which allows a portion of the upper surface of the panel or disc (13) to be exposed through the hole (11). In short then the *Innis reference* fails to teach or suggest a pad " having its upper surface coated with an adhesive material for removably securing said pad to said contoured surface area a body part to facilitate decorating said contoured surface area. Moreover, the *Innis reference* teaches that the function of the sandal is for sanitary purposes and not for "decorating said contoured surface area..."

Finally, the *Innis reference* fails to disclose or teach "said pad having its lower surface provided with indicia to decorate said contoured surface area." In this regard, the *Innis reference* is completely silent relative to the undersurface of the sole (10) having "indicia to decorated said contoured surface area".

Thus, while the *Innis reference* may teach a flexible sheet of material with holes, the *Innis reference* does not disclose, nor suggest, the novel features and steps of the present invention as claimed. Therefore, new claim 21 and dependent claims 1 and 3 as amended and claims 7, 13,15, 17 and 19 patentably distinguish over the *Innis reference*.

It should also be noted that claim 1 as amended specifies:

"1. The novelty fashion wear item of claim 21, further comprising:

a removable layer covering said adhesive material; and

wherein said pad is sufficiently flexible to conform to the contoured shape of body parts selected from the group consisting of feet, hands, knees, elbows, shins, and parts thereof."

The novel features and steps of the present invention are not disclosed, nor suggested by the *Innis reference* in that the *Innis reference* fails to disclose or teach " a removable layer covering said adhesive material...." Instead, the *Innis reference* teaches that the adhesive coated disc (13) is uncovered as it is protected in a well like hole. In short then, the *Innis reference* is completely silent relative to "a removable layer covering said adhesive material."

Finally, with reference to claim 1, the *Innis reference* fails to disclose or teach " wherein said pad is sufficiently flexible to conform to the contoured shape of body parts selected from the group consisting of feet, hands, knees, elbows, shins, and parts thereof."

Instead, the *Innis reference* teaches merely a sanitary sandal that may or may not be flexible but only with reference to footwear and not a novelty fashion wear item that may be utilized to decorate body parts "selected from the group consisting of feet, hands, knees, elbows, shins and parts thereof."

Therefore newly added claim 21, as well as claims 1 and 3 as amended and claims 7, 13,15, 17 and 19 patentably distinguish over the *Innis reference* and are in condition for immediate allowance.

Claim 2 as amended, now depends from new claim 22 which is a method claim modeled after new claim 21. In this regard, new claim 22 and amended claims 2 and 8 as well as dependent claims 14, 16, 18, and 20 patentably distinguish over the prior art of record, whether taken alone or in combination with one another, and more particularly over the *Innis reference* under the same rationale as set forth above with reference to claims 21 and 1. Therefore claims 2 and 8 as amended and dependent claims 14, 16, 18, and 20 patentably distinguish over the *Innis reference* and are in condition for immediate allowance.

Claims 6 and 11 have been rejected under 35 USC §103 as being unpatentable over *Innis (U.S. 1,980,621 in view of McCarthy (U.S. 2,985,970))*.

The McCarthy reference teaches a hard sole shoe that is adapted to be adhesively secured to the feet.

Claims 6 and 11 have been amended to provide a proper antecedent basis for "said bottom layer", and for broaden purposes by substituting --a first securing material layer-- for "a first layer of thistle cloth" and by substituting --a second securing material layer-- for "a second layer of thistle cloth". Except for these clarifying and broadening amendments to claims 6 and 11, claims 6 and 11 patentably distinguish over *Innis (U.S. 1,980,621 in view of McCarthy (U.S. 2,985,970))* under the same rationale as set forth above relative to claims 1 and 2. More particularly, *Innis (U.S. 1,980,621 in view of McCarthy (U.S. 2,985,970))* fails to teach or disclose "in addition a first securing material layer to at least a portion of said bottom surface and a protective shell having a second securing material layer to engage securingly said first securing material layer...." In addition, *Innis (U.S. 1,980,621 in view of McCarthy (U.S. 2,985,970))* also fails to disclose or suggest, "means for absorbing the shock of a blow to said shell."

Based on the foregoing, claims 6 and 11 as amended are now in condition for immediate allowance and such action is respectfully requested.

#### **Conclusion**

Attorney for Applicant has carefully reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason

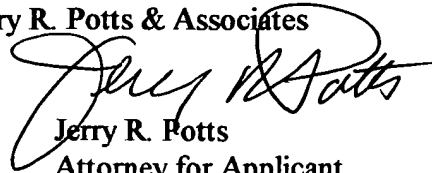
that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Jerry R. Potts, Esq. at the below-listed telephone number.

Dated: September 30, 2002

Respectfully submitted,

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**VERSION WITH MARKING TO SHOW CHANGES MADE**

Claims 1-6 and 8-11 have been amended as follows:

1. (Amended) The [A] novelty [kit for providing decorative and disposable fashion wear for body parts selected from the group consisting of feet, hands, knees, elbows, shins, and parts thereof that also protects the decorated body parts from abrasion,] fashion wear item of claim 21, further comprising:

- [a] a flexible, trimmable pad having top and bottom surfaces;
  - b) an adhesive material on said top surface for removably securing said pad to a body part;
  - c) a decoration to be applied to said bottom surface; and
  - d)] a removable layer covering said adhesive material; and
- said pad being sufficiently flexible to conform to the contoured shape of body parts selected from the group consisting of feet, hands, knees, elbows, shins, and parts thereof.

2. (Amended Twice) [A] The method of decorating [and protecting] a body part [selected from the group consisting of feet, hands, knees, shins, elbows, and parts thereof,] according to claim 22, further comprising the steps of:

[a) furnishing a flexible pad having top and bottom surfaces;]

[b)] providing [an adhesive on said top surface and] a peelable film to ~~cover and~~ preserve said adhesive material until used;

[c) providing decoration] ~~wherein the step of providing the lower surface with indicia includes:~~

~~selecting the indicia [selected] from at least one of the group comprising color, pattern, graphic design, text, advertising, relief design and texture;~~

~~wherein the step of providing a pad includes:~~

[d)] trimming said pad to a desired shape to apply to the ~~contoured surface area of~~ at least one [of said] body [ parts] ~~part selected from the group comprising feet, hands, knees, and elbows, and parts thereof; and~~

~~providing a flexible pad;~~

[e)] peeling said film from said adhesive material; and

applying said pad to said selected body part.

3. (Amended) The [invention] ~~novelty item of claim 1 [further comprising], wherein said adhesive material is a reusable adhesive material allowing said pad to be removably secured more than once.~~

4. (Amended) [The invention of claim 1 further] ~~A novelty kit for providing decorative and disposable fashion wear for body parts that also protects the decorated body parts from abrasion, comprising:~~

~~a flexible, trimmable pad having top and bottom surfaces;~~

~~an adhesive material on said top surface for removably securing said pad to a body part;~~

~~a decoration to be applied to said bottom surface;~~

~~a removable layer covering said adhesive material; and~~



pre-formed, cupped pads for at least one of toes, knees, elbows, and animal pads.

5. (Amended) [The invention of claim 1 further] ~~A novelty kit for providing decorative and disposable fashion wear for body parts that also protects the decorated body parts from abrasion, comprising:~~

~~a flexible, trimmable pad having top and bottom surfaces;~~  
~~an adhesive material on said top surface for removably securing said pad to a body part;~~  
~~a decoration to be applied to said bottom surface;~~  
~~a removable layer covering said adhesive material; and~~  
~~material selected from cushioning, magnetic material, and gel disposed in said pad between said top and bottom surfaces.~~

6. (Amended) The invention of claim 1, further comprising:

the addition of a first securing material layer [of thistle cloth] to at least a portion of said bottom [layer] surface and a protective shell having a second securing material layer [of thistle cloth] to engage securingly said first securing material layer [of thistle cloth]; and means for absorbing the shock of a blow to said shell.

8. (Amended) The invention of claim 2 [further comprising], ~~wherein said step of providing the upper surface with an adhesive material includes providing the upper surface with a reusable adhesive material.~~

9. (Amended) [The invention of claim 2 further] ~~A method of decorating and protecting a body part comprising the steps of:~~

~~furnishing a flexible pad having top and bottom surfaces;~~  
~~providing an adhesive on said top surface and a peelable film to preserve said adhesive until used;~~

providing decoration selected from at least one of the group comprising color, pattern, graphic design, text, advertising, relief design and texture;

trimming said pad to a desired shape to apply to at least one body part selected from the group comprising feet, hands, knees, and elbows, and parts thereof;

peeling said film from said adhesive and applying said pad to a selected body part;  
and

pre-formed cupped pads for at least one of toes, knees, elbows and animal pads.

10. (Amended) [The invention of claim 2 further] A method of decorating and protecting a body part comprising the steps of:

furnishing a flexible pad having top and bottom surfaces;

providing an adhesive on said top surface and a peelable film to preserve said adhesive until used;

providing decoration selected from at least one of the group comprising color, pattern, graphic design, text, advertising, relief design and texture;

trimming said pad to a desired shape to apply to at least one body part selected from the group comprising feet, hands, knees, and elbows, and parts thereof;

peeling said film from said adhesive and applying said pad to a selected body part;  
and

material selected from cushioning, magnetic, and gel disposed in said pad between said top and bottom surfaces.

11. (Amended) The invention of claim 2 further comprising:

providing the addition of a first securing material layer [of thistle cloth] to at least a portion of said bottom [layer] surface and a protective shell having a second securing material layer [of thistle cloth] to engage securingly said first securing material layer [of thistle cloth]; and

providing means for absorbing the shock of a blow to said shell.

New Claims 21-33 have been added as follows:

21. (New) A novelty fashion wear item, comprising:

a flexible pad having an upper surface and a lower surface with a non-slip texture;  
said pad being sufficiently flexible to conform to a contoured surface area of a body part;

said pad having its upper surface coated with an adhesive material for removably securing said pad to said contoured surface area a body part to facilitate decorating said contoured surface area; and

said pad having its lower surface provided with indicia to decorate said contoured surface area.

22. (New) A method of decorating a body part, comprising the steps of:

providing decorative fashion wear;

said fashion wear including:

a flexible pad with a non-slip texture, said pad having an upper surface and a lower surface and being sufficiently flexible to conform to a contoured surface area of the body part;

providing the upper surface with an adhesive material for removably securing said pad to the contoured surface area of the body part;

providing the lower surface with indicia to decorate the contoured surface area of the body part; and

applying said decorative fashion wear to the contoured surface area of the body part for decorating purposes.

23. (New) A fashion wear item, comprising:

a non-slip pad having a non-skin irritating adhesive material covering one of its surfaces and decorative indicia covering at least a portion of another one of its surfaces;

and

a peelable material covering said non-skin irritating adhesive to protect the adhesive material until it is ready for use to facilitating decorating a contoured area of a user selected body part.

24. (New) The fashion wear item according to claim 23, wherein said non-slip pad has a sufficient thickness to protect said contoured area of a user selected body part from abrasion when brought into engaging contact with a ground surface.

25. (New) The fashion wear item according to claim 24, wherein said non-slip pad is a pad of water resistant ethylene vinyl acetate having a thickness of about one sixteenth of an inch.

26. (New) The fashion wear item according to claim 24, wherein said adhesive material is acrylate polyurethane tape having about a 1.2 mil thickness with a layer of skin-compatible adhesive on one of its surfaces for facilitating removably securing said non-slip pad to said contoured area of a user selected body part.

27. (New) The fashion wear item according to claim 23, wherein the decorative indicia is screen printed on said non-slip pad.

28. (New) The fashion wear item according to claim 25 wherein the decorative indicia is screen printed on said pad of ethylene vinyl acetate.

29. (New) The fashion wear item according to claim 23, wherein said non-slip pad is sufficiently flexible to conform to the contour of user selected body part consisting of a group of body parts selected from the hands, fingers, feet, toes, knees and elbows of a user to provide decoration for the body part selected.

30. (New) The fashion wear item according to claim 24, wherein said non-slip pad is selected from a group of materials consisting of rubber, fabric, paper, plastic, synthetic materials, leather, and polyurethane foam.

31. (New) The fashion wear item according to claim 30, wherein said non-slip pad is trimmable and disposable after use.

32. (New) The fashion wear item according to claim 23, wherein the decorative indicia is selected from an indicia group consisting of color, patterns, messages,

trademarks, and advertisements.

33. (New) A decorating method, comprising the steps of:

providing a pad of decorative fashion wear adapted to conform to the contour of a selected body parts; and

removably applying said pad of decorative fashion wear to a selected body part to facilitate decorating said selected body part with decorative indicia.